UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,397	07/19/2001	Robert B. Franks	5897-000008	9903

27572 7590 04/02/2009

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. BOX 828
BLOOMFIELD HILLS, MI 48303

EXAMINER	
AKINTOLA, OLABODE	
ART UNIT	PAPER NUMBER
3691	

MAIL DATE	DELIVERY MODE
04/02/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/909,397	FRANKS ET AL.	
	Examiner	Art Unit	
	OLABODE AKINTOLA	3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *02 December 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date. _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/02/2008 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grainger (USPAP 20020161733) (Grainger1) in view of "Declaration of Use of Mark in Commerce under

§ 8 (15 U.S.C § 1058)" ("TLTIA") in view of Grainger (USPAP 20020091542) (Grainger2) and further in view of Fields (USPAP 20020069154).

Re claims 1, 14, 29-30, 36 and 38-41: Grainger1 teaches a method of determining a cost data relating to a cost of a registered trade mark application (section 0024), said method characterized by comprising the steps of: receiving input data describing a trade mark (Fig. 1, RN{10}); receiving input data describing at least one territory for said registered trademark application (Fig. 1, RN{6}); storing component cost data relating to a plurality of component costs of said registered trade mark application in at least one territory (sections 0008 and 0035).
Grainger1 does not explicitly teach receiving input data describing a number of classes of goods/services for a said registered trade mark application; calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data and said data describing at least one territory and said data describing a number of classes of goods/services, wherein said calculated cost data represents a real time running total transaction cost for said registered trade mark application, said calculated cost data changing substantially in real time on modifying said data describing a number of classes of goods/services of said registered trade mark application. However, Grainger1 teaches applicability of the invention to include trademark and copyrights (section 0024).
TLTIA teaches fee information for trademark application. TLTIA further teaches that the fee is based on the number of classes of goods/services (page 2). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger1 to include the step of inputting the number of classes of goods/services as is normally applicable in the registration of

trademark applications for appropriate fee calculation.

Grainger2 teaches calculating substantially in real time said calculated cost data relating to a cost of said registered trade mark application from said stored component cost data and said data describing at least one territory and said data describing a number of classes of goods/services (Fig. 5; section 0011). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger1 to include this step as taught by Grainger2. One would have been motivated to do this in order to provide a total cost of registering the trademark application. Fields teaches wherein said calculated cost data represents a real time running total transaction cost for said registered trade mark application, said calculated cost data changing substantially in real time on modifying said data describing a number of classes of goods/services of said registered trade mark application (fig. 33, 36A-36B, sections 0043, 0046-0047, 0078, 0096). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger1 to include this step as taught by Fields. One would have been motivated to do this in order to generate a customized fee quote based on the number of classes of goods/services. Examiner notes that the fee for the number of classes of goods/services is considered as part of government fees required for registration. Therefore a customized fee quote for an application having a single class ($100 x 1= $100) would be different for the customized fee quote having 20 classes ($100 x 20 = $2000).

Thus the combination of Grainger1, Grainger2, TLTIA and Fields is hereinafter referred to as "Modified Grainger".

Re claim 2: Modified Grainger teaches the step wherein a said calculated cost data is generated by: reading said stored cost data from a look up table comprising a plurality of individual component costs for each of a plurality of individual territories; and adding a plurality of said individual component costs to obtain said calculated cost data (Grainger1: section 0035; Grainger2: Fig 5).

Re claim 3: Modified Grainger teaches the step of: displaying said calculated cost substantially in real time (Grainger2: Fig. 5).

Re claim 4: Modified Grainger teaches the step of: calculating said calculated data cost in a plurality of different currencies (Grainger2: Fig. 5).

Re claim 5: Modified Grainger teaches the step of calculating comprises calculating a said calculated cost in a first currency, and converting said calculated cost to a second currency (Grainger2: Fig. 5).

Re claim 6: Modified Grainger teaches the step of: making said calculated cost data available for substantially real time display (Grainger2: Fig. 5).

Re claim 7: Modified Grainger teaches the step of storing data comprises, for each of a plurality of territories: storing at least one official fee cost data relating to an official fee payable to a

governmental/intergovernmental body; and storing at least one vendor fee cost data relating to a vendor fee charged by a vendor of trade mark services (Grainger1: section 0035; Grainger2: Fig 5).

Re claim 8: Modified Grainger teaches the step of calculating a cost substantially in real time comprises the steps of: reading from a look up table, a vendor filing cost; reading from said look up table an official fee for filing said trade mark; and adding said vendor filing fee cost and said official filing fee cost (Grainger1: section 0035; Grainger2: Fig 5).

Re claim 9: Modified Grainger teaches the step of receiving data describing a trade mark said data comprising inputting a bitmap representing a two dimensional image of said trade mark (Grainger1: Fig. 3J RN{82}, section 0070; Grainger2: Fig 5).

Re claim 10: Modified Grainger teaches the step of storing data relating to cost of said registered trade mark application in said country comprises: for each of a plurality of territories, storing data describing; a plurality of official fee component costs, describing individual official fees for various operations; a plurality of vendor fee component costs, each describing a vendor fee levied for a specific service; a plurality of associate fee component costs, each describing a cost for a service for a specified item levied by an associate (Grainger1: section 0035).

Re claims 11-13: Modified Grainger does not explicitly teach the step comprising: reading from said look up table a vendor priority cost data for claiming a priority, a vendor seniority cost for

claiming a seniority and a vendor designation cost for designation of a territory; and adding said vendor priority cost data, said vendor seniority cost and vendor designation cost to said vendor filing cost and said official filing fee cost. However, Grainger1 teaches applicability of the invention to include trademark and copyrights (section 0024). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger1 to include these steps as normally applicable in the registration of trademark applications.

Re claim 15: Modified Grainger teaches the step wherein said step of displaying comprises making said real time calculated cost available for display via a web server apparatus (Grainger2: Figs. 1 and 5).

Re claim 16: Modified Grainger teaches wherein said displayed cost is recalculated substantially in real time to reflect a modified cost of said trademark for a modification (Grainger2: Fig. 5). Modified Grainger does not explicitly teach modifying a specification of goods/services by selecting/deselecting classes of goods/services. However, Grainger1 teaches creating, modifying and deleting selected case meta data associated with a case (section 0063). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger1 to include this step as normally applicable in the registration of trade mark applications i.e. selecting/deselecting classes of goods/services.

Re claims 17-18: See claims 1 and 16 analyses above.

Re claim 19: Modified Grainger teaches wherein: said step of inputting at least one territory for

said trade mark comprises selecting a plurality of territories from a menu display listing said plurality of territories, said method further comprising the steps of: modifying a selection of said territories by selecting/deselecting individual territory icons on a screen display, to obtain a modified selection of territories; wherein said displayed cost is recalculated substantially in real time to reflect a modified cost of said trade mark for said modified selection of territories (Grainger2: Fig. 5).

Re claims 20-23 and 31-32, 37: Modified Grainger teaches modifying said selection of data by selecting/deselecting to obtain a modified data selection; wherein said displayed cost is recalculated substantially in real time to represent a modified cost of said trade mark for said modified selection (Grainger2: Fig. 5). Modified Grainger does not explicitly teach priority claim and seniority claims. However, Grainger1 teaches applicability of the invention to include trademark and copyrights (section 0024). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Grainger1 to include these steps as normally applicable in the registration of trademark applications.

Re claim 24: Modified Grainger teaches the step of: inputting at least one designated territory for a regional trade mark; wherein said displayed cost is recalculated in real time according to said input of said at least one designated territory (Grainger2: Fig. 5).

Re claim 25: Modified Grainger teaches displaying a set of component costs used for calculating said substantially real time calculated costs; and selecting/deselecting individual said component costs to modify said real time calculated cost of said trade mark (Grainger2: Fig. 5; Grainger1:

sections 0035 and 0063).

Re claim 26: Modified Grainger teaches the step of: selecting a currency of a plurality of different currencies, in which said cost is displayed (Grainger2: Fig. 5).

Re claim 27: Modified Grainger teaches wherein said component costs comprise costs selected from the set: official fees payable to governmental/intergovernmental bodies; and vendor fees levied by a vendor providing a trade mark service (Grainger1: section 0035)

Re claim 28: Modified Grainger teaches displaying a said component cost in a currency selected from a plurality of different currencies (Grainger2: Fig. 5; Grainger1: sections 0035 and 0063).

Re claim 33: Modified Grainger teaches displaying a number of designated territories relating to said trademark (Grainger2: Fig. 5).

Re claim 34. See claim 30 analysis above.

Re claim 35. See claims 30 and 31analyses above.

Response to Arguments

Applicant's arguments filed 12/02/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that TLTIA does not teach certain limitations such as storing component cost data relating to a plurality of component costs of said registered trade mark application in a plurality of territories, examiner respectfully disagrees. Examiner does not rely on the TLTIA reference for this teaching, rather Grainger1 teaches this limitation (see Fig. 1, RN 6 (U.S, EPO, JPO, Others), sections 0008 and 0035). The TLTIA reference is introduced to show that the information regarding number of classes of goods/services relating to trademark applications and how it affects the computation of the fees is old and well known. One of ordinary skill in the art would recognize the advantage of modifying Grainger1 to include these features as applicable to trademark applications to yield a predictable result. Furthermore, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Grainger1 at section 0024 teaches

"It should be apparent that the present invention is not restricted to patent cases. It is to be understood, however, that the present invention is useful for managing other forms of intellectual property including trademarks and copyrights. Accordingly, the description of the present invention set forth below is not intended to limit the scope of the present invention in any way. One of ordinary skill in the art would recognize variations, modifications, and alternatives."

Section 0035 also teaches

"coordinating, tracking and providing payment options for all financial aspects of the patent process including patent office fees, practitioner fees and service provider fees."

Therefore, Grainger1 is not limited to patents only.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the clear motivation is finding applicability in trademarks and copyrights by not limiting the scope of the invention to only patents. By modifying the Grainger1 reference to incorporate trademarks, one of ordinary skill in the art would recognize that the various parameters required in financial aspect of the patent process in Grainger1 would be replaced by the parameters required in financial aspect of the trademark process.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Grainger (USPAP 20020111824) discloses a method of defining workflow rules for managing intellectual property.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691